

REMARKS/ARGUMENTS

Applicants thank the Examiner for his careful review of this application. Claims 1-2 and 4-20 have been rejected. Claims 1, 7, and 16 have been amended. Applicants respectfully request reconsideration of the application in view of the above amendments and the following remarks submitted in support thereof.

Non-Statutory Subject Matter Rejections under 35 U.S.C. §101

In Section 3 of the Office Action, pending claims 1-2 and 4-6 were rejected under 35 U.S.C. §101 because they were directed to non-statutory subject matter. In Section 4 of the Office Action, the Examiner suggested that the Applicant “change ‘method’ to ‘computer implemented method’ in the preamble to overcome the outstanding 35 U.S.C. §101 rejections.”

Applicant notes, as kindly suggested by the Examiner, that the “method” phrase in the preamble of claim 1 has been changed to “computer implemented method.” In view of the foregoing comments, Applicant respectfully submits that the claims overcome the Examiner’s rejection under 35 U.S.C. §101.

In Section 5 of the Office Action, pending claims 7-20 were rejected under 35 U.S.C. §101 because they were “not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement.” In particular, the Examiner asserted in Section 6 of the Office Action, “Claim 7 is rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter as not being tangible because [a] profile data structure claims do not require the use of hardware computer to perform, and would not result in a practical application producing a useful, concrete, an[d] tangible result to form the basis of statutory subject matter under 35 USC 101.”

Applicant notes that Claim 7 has been amended to include a structural and functional interrelationship between the “profile data structure” and a “computer” according to the guidelines for claiming data structures which are set forth in the MPEP §2106, Paragraph III.B.1.a. In view of the foregoing comments, Applicant respectfully submits that the amended Claim 7 and the claims that depend therefrom overcome the Examiner’s rejection under 35 U.S.C. §101.

Further, the Examiner asserted in Section 7 of the Office Action, “Claim 16 defines ‘System’ in the preamble and the body of the claim recites ‘an operating dependent code,’ ‘an operating independent code.’ An operating dependent code and an operating independent code appear to be software modules, which are not tangible. Therefore, claim 16 is non-statutory because it recites a system claim that comprises non-tangible embodiments.

Applicant notes that Claim 16 has been amended to recite the “operating dependent code module” and the “operating independent code module” executed by a “computer” in accordance with the guidelines for claiming computer programs which are set forth in the MPEP §2106, Paragraph III.B.1 (“Computer programs are often recited as part of claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that the computer program is included in the claim.”). In view of the foregoing comments, Applicant respectfully submits that the amended Claim 16 and the claims that depend therefrom overcome the Examiner’s rejection under 35 U.S.C. §101.

Obviousness Rejections under 35 U.S.C. §103(a)

In Section 8 of the Office Action, pending claims 1-2 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,954,796 to McCarty et al. in view of U.S. Patent No. 6,418,555 B2 to Mohammed. In Section 13 of the Office Action, pending claims 4-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,954,796 to McCarty et al. in view of U.S. Patent No. 6,418,555 B2 to Mohammed, as applied to claim 1, and further in view of APA (Admitted Prior Art).

As will be fully explained below, the combination of McCarty et al. in view of Mohammed and the combination of McCarty et al. in view of Mohammed, as applied to claim 1, and further in view of APA do not raise a *prima facie* case of obviousness against amended independent claims 1, 7 and 16.

The Applicants previously amended the original independent claims 1, 7 and 16 to clarify that there were no translations into Fibre Channel Commands (see Response to Advisory Action dated August 30, 2004). Accordingly, independent claims 1 and 16 defined receiving a modification request to alter a Fibre Channel attribute during operation of the Fibre Channel controller without the modification request being translated into Fibre Channel commands to carry out the modification request. Similarly, amended independent claim 7 defined the operating system dependent code module accessing a value in a Fibre Channel value field without translation into Fibre Channel.

Although the Applicants believe that pending claims 1, 7, and 16 are defined over the art of record, the Applicants have amended independent claims 1, 7 and 16 to further clarify that there is no translation into Fibre Channel commands since modifying or accessing Fibre Channel attributes is done directly and does not require the use of Fibre Channel commands to carry out the modification or access.

In support of the 35 U.S.C. §103(a) rejection, the Examiner first acknowledged that McCarty et al. “does not explicit[ly] teach the term ‘alter the attribute of [the] controller without the modification request being translated into Fibre Channel commands’” (see Office Action mailed July 12, 2005 at Section 10). The Examiner then noted that Mohammad teaches altering the attribute of the controller without the modification request being translated into Fibre Channel command because a “detection module 154 retrieves the command line, which may be stored in a command entry of the operating system registry 166 that is used to invoke upgrade modules 156” (see Office Action mailed July 12, 2005 at Section 10). The Examiner also noted that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of McCarty and Mohammad because Mohammad’s alter the attribute of controller without the modification request being translated into Fibre channel commands would improve the efficiency of McCarty’s system by allowing the software components such a[s] device drive[r] are [sic] automatically upgraded when a system migrates from one operating system to another” (see Office Action mailed July 12, 2005 at Section 11).

Applicants respectfully traverse the Examiner’s characterization of Mohammad relative to amended independent claims 1, 7, and 16. In particular, Mohammad discloses a “registry 166” (col. 5, lines 20-21) whose entries may include “a Platform entry, a Restart entry, and a Command entry” (col. 3, lines 24-25) where “[t]he Command entry may specify the **command line** to invoke when an operating system upgrade is detected” (col. 3, lines 30-32) (emphasis added). Mohammad further discloses “the detection module 154 next retrieves (at 326) the **command line**, which may be stored in the Command entry of the operating system registry 166 that is used to invoke the upgrade module 156” (col. 5, lines 17-20) (emphasis added). Applicants respectfully submit that a command line is generally

recognized by those of ordinary skill in the art as a line of textual **commands** used to interact with a device. Accordingly, Mohammad teaches that all communications from the OS must be translated into commands by using command lines. In contrast, amended independent claims 1, 7, and 16 define the operating system dependent code module modifying or accessing Fibre Channel attributes directly without translation into Fibre Channel commands. As Mohammad does not teach the OS being able to directly alter or access the FC information structure associated with the FC devices or any other devices, Mohammad cannot reasonably be considered to teach or suggest the operating system dependent code module directly modifying or accessing Fibre Channel attributes without translation into Fibre Channel commands, as defined in amended independent claims 1, 7, and 16.

To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. Here, in view of the incorrect characterization of Mohammad the references as combined do not teach all the features of the claimed invention. Accordingly, for the above-stated reasons, Applicants submit that amended independent claims 1, 7, and 16 are patentable under 35 U.S.C. §103(a) over McCarty et al. in view of Mohammad and further in view of APA. Claims 2, 4-6, 8-15, and 17-20, each of which depends directly or indirectly from amended independent claims 1, 7, and 16, are likewise patentable under 35 U.S.C §103(a) over McCarty et al. in view of Mohammad and further in view of APA for at least the same reasons set forth for amended independent claims 1, 7, and 16. As a result, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. §103(a) rejection for all pending claims 1-2 and 4-20.

Moreover, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Here, in view of the incorrect characterization of Mohammad the rejection has failed to suggest the

desirability of the combination (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)) (see also MPEP §2143.03 “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination”). As discussed above, Mohammad does not teach altering or accessing the attribute of a controller without translation into Fibre Channel commands. As a result, the combination is not desirable since the combination does not improve the efficiency of McCarty’s system by avoiding the use of Fibre Channel commands to alter or access the attribute of a controller.

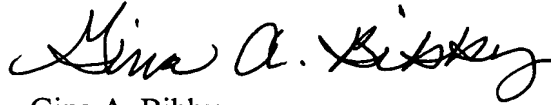
Accordingly, for the above-stated reasons, Applicants submit that amended independent claims 1, 7, and 16 are patentable under 35 U.S.C. §103(a) over McCarty et al. in view of Mohammad and further in view of APA. Claims 2, 4-6, 8-15, and 17-20, each of which depends directly or indirectly from amended independent claims 1, 7, and 16, are likewise patentable under 35 U.S.C §103(a) over McCarty et al. in view of Mohammad and further in view of APA for at least the same reasons set forth for amended independent claims 1, 7, and 16. As a result, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. §103(a) rejection for all pending claims 1-2 and 4-20.

Conclusion

In view of the foregoing, the Applicants respectfully submit that all the pending claims 1-2 and 4-20 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present amendment, the Examiner is requested to contact the undersigned at (408) 749-6920. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. ADAPP169). A duplicate copy of the transmittal is enclosed for this purpose.

U.S. Application No. 09/687,244
Amendment dated October 6, 2005
Reply to Office Action of July 12, 2005

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read "Gina A. Bibby". The signature is fluid and cursive, with the first name "Gina" being the most prominent.

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